

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 21, 2009. Through this response, no claims have been amended. Reconsideration and allowance of the application and pending claims 1-50 are respectfully requested.

I. Claim Objections

The non-final Office Action (page 2) indicates that claims 25 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants appreciate the Examiner's indication of allowability, though it is respectfully noted that claims 25 and 50 are independent claims. Accordingly, it is respectfully requested that the objection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1-7, 11-22, 26-32 and 35-47 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Publication No. 2002/0174430 to *Ellis et al.* (herein, "*Ellis*"). Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

Therefore, every feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every claimed feature is represented in the *Ellis* reference.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. A media content recording system in a subscriber network television system, comprising:

a memory for storing logic;

 a storage device comprising a buffer space for continuously buffering media content instances, the buffer space comprising at any one instance of time plural media content instances corresponding to different video programs; and

a processor configured with the logic to represent each of the media content instances in the buffer space as a respective management file stored in the memory, the management file comprising a data structure that includes information identifying a corresponding media content instance of the media content instances, the information including media guide scheduled start and end times.

Applicants respectfully submit that *Ellis* is an improper anticipatory reference, and hence a *prima facie* rejection has not been established. The present application has an effective filing date of December 6, 2001. The citations used in the rejection are based on the disclosure set forth in the *Ellis* utility (patent publication 2002/0174430), which has an effective filing date of February 21, 2002, which is subsequent to Applicants' effective filing date and hence not anticipatory art. Despite the request for evidence in the previous response, no such evidence has been proffered by the Patent Office to show anticipation by a disclosure corresponding to one or more of the provisional applications from which *Ellis* relies upon for priority. Hence, a *prima facie* rejection has not been established. For at least this reason, Applicants respectfully submit that claim 1 is allowable over *Ellis* and respectfully request that the rejection be withdrawn.

In addition, Applicants respectfully submit that *Ellis* fails to disclose, teach or suggest at least the above-described features. Reference is made (on page 3 of the non-final Office Action) to paragraphs 0475, 0476, and Figures 11, 24, 34, and 111, of *Ellis* for alleged disclosure of the above-emphasized features. Paragraphs 0475 and 0476 of *Ellis* provide as follows:

[0475] The computational tasks associated with a digital video recorder are not in general excessive. A processor in such a device typically has spare processor cycles available. These spare cycles may be used to compress stored audio/video programs more efficiently.

[0476] For example, the system may record programs using the MPEG-2 standard, the same as other existing systems. However, in the background, using processor cycles that are not needed for storing, managing, and retrieving programs, the processor may scan through previously stored programs and compresses them in a more efficient format. After compressing a program in a more efficient format, such as MPEG-4, the less efficient version can be deleted, freeing up storage space for additional programs.

These sections on processor cycles and compression technology are not relevant to the features emphasized above. Further, the referenced figures fail to explicitly describe anything about the underlying file management structure involved in the various displays, and certainly do not disclose the above-emphasized features. For instance, Figure 111 is described in *Ellis* in paragraph 0456 as follows (emphasis added):

[0456] FIG. 111 shows an illustrative sequence of display screens that may be presented based on the steps shown in FIG. 110. Program buffer display screen 8402 may be displayed when a user selects a buffer listing option from an appropriate display screen (e.g., a main menu display screen) in a program guide. Program buffer display screen 8402 may include list 8404 identifying programs that are presently available from a buffer.

Display screens are not management files. Even assuming *arguendo* one can infer that the list 8404 in Figure 111 is somehow mirrored as a “file” at the application level, for instance, a single file of plural programs is not the same as “representing” each of the

media content instances in the buffer space as a respective management file. The other referenced figures are at least equally flawed in their lack of relevance to the claim language. Indeed, a thorough review of the entire disclosure of *Ellis*, and not just the citations provided in the non-final Office Action, fails to uncover any disclosure or suggestion of the above-emphasized claim language. Should the rejection be maintained, Applicants respectfully invite the Office in the next action to particularly point to the section(s) (of course in one or more of the provisionals from which *Ellis* claims priority) that allegedly supports anticipation of the claim language and explain how the corresponding disclosure allegedly reads on the claim language, or alternatively, allow the claim. For at least this additional reason, Applicants respectfully submit that claim 1 is allowable over *Ellis* and respectfully request that the rejection be withdrawn.

Because independent claim 1 is allowable over *Ellis*, dependent claims 2-7 and 11-22 are allowable as a matter of law for at least the reason that the dependent claims 2-7 and 11-22 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 26

Claim 26 recites (with emphasis added):

26. A media content recording method in a subscriber network television system, comprising the steps of:

buffering media content instances into a buffer space, the buffer space comprising at any one instance of time plural media content instances corresponding to different video programs; and

representing each of the buffered media content instances as a management file in a memory separate from the buffer space.

Applicants respectfully submit that *Ellis* is an improper anticipatory reference, and hence a prima facie rejection has not been established. The present application has an effective filing date of December 6, 2001. The citations used in the rejection are based on

the disclosure set forth in the *Ellis* utility (patent publication 2002/0174430), which has an effective filing date of February 21, 2002, which is subsequent to Applicants' effective filing date and hence not anticipatory art. Despite the request for evidence in the previous response, no such evidence has been proffered by the Patent Office to show anticipation by a disclosure corresponding to one or more of the provisional applications from which *Ellis* relies upon for priority. Hence, a *prima facie* rejection has not been established. For at least this reason, Applicants respectfully submit that claim 26 is allowable over *Ellis* and respectfully request that the rejection be withdrawn.

In addition, Applicants respectfully submit that *Ellis* fails to disclose, teach or suggest at least the above-described features. Reference is to Figure 111 of *Ellis* for alleged disclosure of the above-emphasized features. Figure 111 is described in *Ellis* in paragraph 0456 as follows (emphasis added):

[0456] FIG. 111 shows an illustrative sequence of display screens that may be presented based on the steps shown in FIG. 110. Program buffer display screen 8402 may be displayed when a user selects a buffer listing option from an appropriate display screen (e.g., a main menu display screen) in a program guide. Program buffer display screen 8402 may include list 8404 identifying programs that are presently available from a buffer.

Display screens are not management files. Even assuming *arguendo* one can infer that the list 8404 in Figure 111 is somehow mirrored as a “file” at the application level, for instance, a single file of plural programs is not the same as ***representing each of the buffered media content instances as a management file in a memory separate from the buffer space***. For at least this additional reason, Applicants respectfully submit that claim 26 is allowable over *Ellis* and respectfully request that the rejection be withdrawn.

Because independent claim 26 is allowable over *Ellis*, dependent claims 27-32 and 35-47 are allowable as a matter of law.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 8-10, 23, 24, 33-35, 48 and 49 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ellis* in view of U.S. Patent No. 6,625,811 to *Kaneko*. Applicants traverse this rejection.

B. Discussion of the Rejection

The U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the cited art of record. In particular, *Ellis* fails to represent an anticipatory reference and, in addition, fails to disclose, teach, or suggest at least the above-emphasized features of claims 1 and 26. The addition of *Kaneko* does not cure these deficiencies. Accordingly, independent claims 1 and 26 are allowable over *Ellis* in view of *Kaneko*. For at least the reason that dependent claims 8-10, 23, 24, 33-35, 48 and 49 incorporate these allowable claim features, claims 8-10, 23, 24, 33-35, 48 and 49 are allowable as a matter of law and hence Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/David Rodack/
David Rodack
Registration No. 47,034

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-9946
Telephone: 404.954.5066